



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,856	03/23/2004	Andrew B. Sparks	061834-5028-US	6556
9629	7590	04/07/2006	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			SHIBUYA, MARK LANCE	
			ART UNIT	PAPER NUMBER
			1639	
DATE MAILED: 04/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/807,856	Applicant(s) SPARKS ET AL.	
	Examiner Mark L. Shibuya	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,42 and 103-109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,42 and 103-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 42, 103-109 are pending and examined.

Priority

2. This application is a divisional of 09/879,957, filed 6/13/2001, now U.S. Patent No. 6,709,820; which is a divisional of U.S. patent application Serial No. 08/630,915, filed April 3, 1996, now U.S. Patent No. 6,309,820; which is a continuation-in-part of abandoned U.S. Patent Application Serial No. 08/417,872, filed April 7, 1995, the entire contents of which are incorporated herein by reference.

3. Applicant's amendment to the first line of specification, entered 12/16/2005, so as to claim priority to divisional application No. 09/879,957, filed 6/13/2001, now U.S. Patent 6,709,820, is acknowledged.

Withdrawn Claim Rejections

4. The rejection of Claims 1, 42, 103-109, under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, is withdrawn in view of applicant's arguments and amendments to the claims, entered 12/16/2005.

5. The rejection of Claims 1, 42, 103-109 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "recognition units"

Art Unit: 1639

comprising SH2 or SH3 domains, does not reasonably provide enablement for any "recognition unit", is withdrawn in view of applicant's arguments and amendments to the claims, entered 12/16/2005.

6. The rejection of Claims 1, 42, 103-109, under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, particularly in regard to the term "decreased" in describing binding specificity, is withdrawn in view of applicant's arguments.

7. The rejection of Claims 1, 42, 103-109 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6309820 B1, is withdrawn in view of applicant's arguments and amendments to the claims, entered 12/16/2005.

8. The rejection of Claims 1, 42, 103-109 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,709,821 B2, is withdrawn in view of applicant's arguments and amendments to the claims, entered 12/16/2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1639

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 42, 103-109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is necessitated by applicant's amendments to the claims, entered 12/16/2005.

The claims as newly amended are drawn to a domain of interest --selected from the group consisting of GST, SH1, PH, PTB, LIM, armadillo, Notch/ankyrin repeat, zinc fingers, leucine zippers, helix-turn-helix and helix-loop-helix--, which renders the claim vague and indefinite. Firstly, the abbreviations "GST, SH1, PH, PTB, and LIM" are unclear because these abbreviations have more than one meaning or definition in the art. For example, in addition to the protein glutathione S-transferase, as taught in the specification at p. 32, lines 17-18, the abbreviation "GST", may have the meaning "genomic sequence tag", as in claim 1 of US 7,018,794. The examiner respectfully submits that the names for the proteins for which abbreviations SH1, PH, PTB, and LIM" stand, do not appear to be set forth in the specification. Thus it is unclear as to what proteins are named by the abbreviations, the abbreviations are not defined by the claims, and of skill in the art would not be reasonably apprised of the metes and bounds of the claimed invention. Secondly, the claims are drawn to domains, however glutathione S-transferase is a whole protein and not merely a domain of a protein. Therefore it is unclear as to whether "GST" is a domain of a protein, as in the claims, or the whole, named protein "glutathione S-transferase", as in the specification.

Conclusion

10. Claims 1, 42, 103-109 are rejected. Claims 1, 42, 103-109 are free of the prior art.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

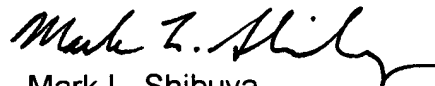
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shibuya whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

Art Unit: 1639

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark L. Shibuya
Examiner
Art Unit 1639

ms